

REMARKS

In an Office action dated October 28, 2009 (the “Office Action”), the Examiner considered claims 1-6, following which claims 1-6 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,620,456 to Sauer et al. (“Sauer”). The action was made final.

All rejections are respectfully traversed, and the following remarks concerning the Office Action are respectfully submitted. This paper is presented as a submission under 37 C.F.R. § 1.114 in connection with a request for continued examination being filed concurrently with this paper.

Interview Requested

As set forth in the PTO-413A form filed with this paper, the undersigned requests a telephonic interview with the Examiner and the appropriate Supervisory Patent Examiner to discuss the Office action and this reply, prior to any further action in this application other than an allowance of claims 7-12. The undersigned can be contacted as set forth below to schedule the interview.

The Finality of the Office Action Is Improper

Although the Office Action simply continues and repeats the rejections set forth in the first Office action in this application, making the second action final was inappropriate in light of the deficiency of the first action. For the first time, the final action provides enough information for the original January 2009 action to be understood sufficiently to rebut the rejections.

In responding to the reply filed July 27, 2009, the Office Action for the first time identifies that the rejections are based on the allegation that the first axis lies along slot 124 in Figures 11-13 of Sauer. Although belated, this explanation is appreciated, so that a sufficient understanding of the rejections can inform further action in the case.

The explanation, however, should have appeared in first action (dated January 27, 2009), because without an explanation sufficient to understand the rejections, the first action failed to comply with statutory requirements and the rules of practice at the Office. *See* 35 U.S.C. §

132(a); 37 C.F.R. § 1.104(c)(2); MPEP § 707. Accordingly, it was inappropriate to make the Office Action final.

Nevertheless, to minimize further expense and delay in the prosecution of this application, a request for continued examination is submitted along with this reply.

Rejections Based on Sauer

The traversal of the rejections of claims 1-6 based on Sauer is maintained and repeated. Nevertheless, in further effort to reduce expense and delay in prosecution of this application, claims 1-6 are canceled. Claims 7-12 are added to clarify the scope of the claims, without any narrowing of the scope.

Although claim 1 distinguished over Sauer, claim 7 does so without inviting a rejection based on an unreasonable claim construction divorced from the context of the specification. As set forth in claim 7, none of the first, second, and third axes are parallel or collinear. The sectioning component is adapted to slide linearly along the first axis. The first piston is adapted to slide linearly along the second axis. And the second piston is adapted to slide linearly along the third axis.

Sauer clearly lacks the structure specified in claim 7. Even assuming that the Office Action appropriately identifies drive member 50 as the first piston and pin 60 as the second pin (which is not agreed or conceded), drive member 50 and pin 60 clearly do not move linearly along axes that are not parallel or collinear. And even assuming that the Office Action appropriately identifies sectioning means slide mounted in a “base” along an axis that is the slot 124 of figures 11-13 of Sauer, the alleged sectioning means do not comprise a sleeve, which the Office Action alleges to be Sauer’s sleeve 42. In light of these clear omissions in Sauer, Sauer’s other defects need not be addressed at this time.

In addition, claims 1 and 7 both require that the base be adapted to protect the medullar canal when sectioning the lamina. This aspect of claims 1 and 7 defines structural attributes of the interrelated component parts of the claimed assembly, and thus must be evaluated and considered, just like any other limitation of the claims, for what it fairly conveys to a person of ordinary skill in the art in the context in which it is used. *See, e.g.*, MPEP § 2173.05(g); *In re Swinehart*, 439 F.2d 210 (CCPA 1971); *In re Venezia*, 530 F.2d 956 (CCPA 1976). The alleged

“base” of Sauer is not alleged to have any corresponding structure or to be capable of protecting the medullar canal when sectioning a lamina. In fact, Sauer appears to be in capable of so protecting the medullar canal.

For at least the reasons set forth above, the timely allowance of claims 7-12 is respectfully requested.

Conclusion

In view of the reasons given above, reconsideration of this application and the timely allowance of pending claims 7-12 are respectfully requested. It is believed that this paper addresses all of the pending claims and other matters sufficiently to support the allowance of all of the pending claims. If the Examiner believes any further issues in this case hinder issuance of a notice of allowance of all pending claims, the courtesy of a telephone interview with the undersigned is respectfully requested *before* a next action in this case.

The Office Action contains a number of statements potentially reflecting characterizations of various claims, supporting descriptions, and/or references, but regardless of whether any such statements are addressed in this response, the Principal (as defined in 37 C.F.R. § 1.32(a)(3)) declines to automatically subscribe to any statement or characterization in the Office action. Although the Examiner's rejections of claims 1-6 have been mooted without reference to many such statements, all rights to dispute statements regarding such rejections later in any subsequent applications or causes of action relating to this application or any other application are expressly reserved.* Accordingly, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above are not exhaustive, there are reasons for patentability of the prior and currently pending claims (and other claims) that have not been expressed. Nothing in this paper should be construed as conceding any issue with regard to any

* In particular, the rejections of the dependent claims have not been addressed herein apart from their independent base claim, but all rights to dispute statements regarding such rejections later in this or any subsequent applications or causes of action relating to this application or any other application are expressly reserved.

claim except as specifically and expressly stated in this paper, and the cancelation of claims 1-6 and/or the addition of claims 7-12 should not be construed as conceding the unpatentability of any claim prior to cancelation or addition.

The Commissioner is hereby authorized by this written request to treat this or any concurrent or future reply that requires a petition for an extension of time under 37 C.F.R. § 1.136(a) for its timely submission as incorporating a petition for extension of time for the appropriate length of time. The Commissioner is further authorized to charge all required fees, including without limitation excess claim fees or other fees under 37 C.F.R. § 1.16 or any required extension of time fees or other fees under 37 C.F.R. § 1.17, to Deposit Account No. 50-5159, on which the undersigned is authorized to sign, and to treat such authorization to charge Deposit Account No. 50-5159 as a constructive petition for an extension of time in this or any concurrent or future reply requiring a petition for an extension of time under 37 C.F.R. § 1.136(a) for its timely submission. The Commissioner is further hereby authorized to credit any overpayment to Deposit Account No. 50-5159.

Please direct all correspondence in this application to the following:

PTO CUSTOMER NO: 91689

Respectfully submitted,

Date: April 28, 2010

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